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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,209	12/01/2003	Michael D. Grah	D-43583-01	4463

7590 09/12/2005

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EXAMINER

MCCLENDON, SANZA L

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,209

Applicant(s)

GRAH ET AL.

Examiner

Sanza L. McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/05 905 9/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 12, 2005 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-17, 36-38, 51-57 and 60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, 13, 24, 30-31 of copending Application No. 10/452,892 and 2004/0241482. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The co-pending application is a film (article) comprising a second layer comprising at least 50-wt% of one or more tie polymers and at least 0.5-wt% of nano-particles, while the instant applicant is a method of increasing the gas transmission rate of a package film, wherein the film comprises at least 0.001-wt% of a single-walled nanotube material. The instant applicant is a method while the co-pending(s) is an articles, however per the teachings of the disclosure of 10/452, 892 and 2004/0241482 the second layer is obtained by the same method as found in the

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instant claims—see co-pending application [0016], which teaches said layers (including the second layer) may be exposed to irradiation and [0138] teaches optional exposure to energetic radiation. Additionally 10/450,892 and 2004/0241482 teaches that the nano-particles can be carbon-based materials, such as single-walled nanotubes—see [0051]. Per [0029] of 10/452,892 said second layer comprises a dispersion of nano-particles dispersed therein; said weight percentages of the nanoparticle/tie layer can be found. These correspond to those claimed in the instant invention. The amount of a said nanoparticles can be found in [0041] of the co-pendings, wherein these correspond to the claimed amounts of nano-tubes. It appears that the polymer of 10/452,892 and 2004/0241482 are different than the instant polymers of the film in the instant method; however the examiner deems that the broad teaching of film includes those filmmaking polymers as disclosed in the co-pending applications. Additionally, since the method of the instant invention can be found in the claims/teachings of the co-pending applications the properties claimed by the instant invention should inherently be found in the co-pending applications. Therefore it would have been obvious for a skilled artisan to obtain the instantly claimed method from the teachings of the above listed co-pending applications in the absence of evidence to the contrary and/or unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-16, 20-39, and 44-57 of copending Application No. 10/749,451 and 2005/0142313. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The differences appears to be the instant application is a method of increasing the gas transmission rate of a package film, while the co-pending applications are directed to a method of shrinking a film. The examiner deems these overlap because both describe exposing films comprising at least 0.001% by weight of a single-walled nanotube to irradiation. While the co-pending applications specify films made from thermoplastic polymer, the examiner deems thermoplastic polymer films are encompassed in the films of the instant claims. In addition, per [0009] of the co-pending applications teach the claimed polymers of instant application. Instant claims 2-7 can be found in the disclosure of the co-pending applications at paragraph [0103] and in claim 8 of said co-pending applications. The duration of non-ionizing radiation found in the instant claims can be found in claim 9 and in paragraphs [0099] – [0100] of the disclosure of said co-pending applications. The intensity as instantly claimed corresponds to claims 10-12 and paragraphs [0103]. Said instantly claimed absorbed dose of radiation can be found in the teachings of said co-pending applications per paragraph [0092]. Instant claims 12-17 correspond to claims 13-16

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and paragraphs [0115] – [0117] of the co-pending disclosures. Instant claim 18 corresponds to the teachings at [0009] of the co-pendings. Instant claims 18-21 corresponds to the teachings found in paragraphs [0055] – [0059]. Instant claims 22-25 correspond the teachings as found in the entire co-pending disclosures. Instant claims 26-29 correspond to claims 20-23 and [0099] of the co-pending disclosures. Instant claims 30-32 and 35 correspond to claims 24-27 and [0098] of the co-pending disclosures. Instant claims 36-38 correspond to co-pending claims 28-32. Instant claims 39-41 correspond to co-pending claims 33-35 and the disclosures at [0108] – [0110]. Claims 42-51 correspond to co-pending claims 36-39 in combination claims 45-54 and paragraphs [0108] – [0110]. Claims 52-60 correspond to co-pending claims 55-57 and teachings of the disclosure [0121] – [0124] and [0115] – [0117]. Therefore it would have been obvious for a skilled artisan to obtain the instantly claimed method from the teachings of the above listed co-pending applications in the absence of evidence to the contrary and/or unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-17, 36-38, 51-57 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Grah et al (2004/0241482)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not

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claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

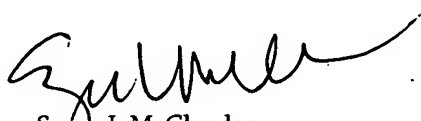
Grah et al discloses PVDC films with nanocomposite tie layers. Said tie layer is a tie polymer with nano-particles uniformly dispersed therein. Said second layer is obtained by the same method as found in the instant claims—see co-pending application [0016], which teaches said layers (including the second layer) may be exposed to irradiation and [0138] teaches optional exposure to energetic radiation. Additionally Grah et al teaches that the nano-particles can be carbon-based materials, such as single-walled nanotubes—see [0051]. Per [0029] said second layer comprises a dispersion of nano-particles dispersed therein, said weight percentages of the nanoparticles/tie layer can be found. These correspond to those claimed in the instant invention. The amount of a said nanoparticles can be found in [0041], wherein these correspond to the claimed amounts of nano-tubes. It appears that the polymer Grah et al are different than the instant polymers of the film in the instant method; however the examiner deems that the broad teaching of film includes those filmmaking polymers as disclosed by Grah et al. Additionally, since the method of the instant invention can be found in the claims/teachings of Grah et al the properties claimed by the instant invention should inherently be found in the Grah et al tie polymer layer.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanza L. McClendon
Examiner

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